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| EXAMINER | |
|---|---|
| OLSZEWSKI, JOHN | |
| ART UNIT | PAPER NUMBER |
| 3618 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/506,761 | HAEGELE ET AL. | |
| | Examiner | Art Unit | |
| | JOHN R. OLSZEWSKI | 3618 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *24 July 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1 and 3-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,4,11-13,15,16 and 19-22* is/are rejected.

7)☒ Claim(s) *5-10, 14, and 17-18* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. **Claim 22 recites the limitation "the axle carrier" in the second line of claim 22.** There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**2. Claims 1-4, 11-13, 15-16, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over von der Ohe et al. (US 4,453,740).**

*With regards to claim 1, von der Ohe et al. discloses:*

- An internal combustion engine (Column 1, Lines 28-30)
- A protruding component surrounding the engine (Figure 1; depicts multiple protruding components and clearly surrounds an engine)

- At least one protective lining attached to at least one area of the protruding component
    - Examiner takes official notice that it is old and well known in the art to paint and/or undercoat an axle carrier, as such painting or undercoating provides a protective lining, protecting the axle carrier from corrosion as well as many other threats to an axle carrier. Therefore it would have been obvious to paint and/or undercoat the axle carrier of von der Ohe et al.
        - ***Definition of lining: material used to cover or coat an inside surface (provided by Webster's II Dictionary)***
- The lining is a material provided with heat-insulating properties
    - Examiner takes official notice that it is old and well known in the art to paint and/or undercoat an axle carrier, as such painting or undercoating provides heat-insulating properties as opposed to a bare metal surface. Therefore it would have been obvious to paint and/or undercoat the axle carrier of von der Ohe et al.
- The material of the lining has sound-insulating properties
    - Examiner takes official notice that it is old and well known in the art to paint and/or undercoat an axle carrier, as such painting or undercoating provides sound-insulating properties as opposed to a bare metal surface. Therefore it would have been obvious to paint and/or undercoat the axle carrier of von der Ohe et al.

*With regards to claim 3, von der Ohe et al. discloses:*

- The protruding component is an axle carrier (Figure 1, Item 1)

*With regards to claim 4, von der Ohe et al. discloses:*

- The material of the lining comprises an elastomer-modified thermoplastic
    - Examiner takes official notice that it is old and well known in the art to undercoat an axle carrier, as such undercoating is well-known to be a thermoplastic. Therefore it would have been obvious to paint and/or undercoat the axle carrier of von der Ohe et al.

*With regards to claim 11, von der Ohe et al. discloses:*

- The linings of individual cover points are joined together in one piece
    - Examiner takes official notice that it is old and well known in the art to undercoat an axle carrier, as such undercoating is inherently applied as a lining and can cover several individual points and maintains itself as a unitary lining comprised of one piece. Therefore it would have been obvious to paint and/or undercoat the axle carrier of von der Ohe et al.

*With regards to claim 12, von der Ohe et al. discloses:*

- The two longitudinal sides of the axle carrier extending parallel to the vehicle longitudinal axis, are fully covered by the lining with the exception of the fastening points, for fastening to the longitudinal member, and the engine mount
    - Examiner takes official notice that it is old and well known in the art to paint and/or undercoat an axle carrier, as such painting or undercoating provides a lining that can be placed on any portion desirable, and can be

left off of portions in which a lining is not desired. Therefore it would have been obvious to paint and/or undercoat the axle carrier of von der Ohe et al.

*With regards to claim 13, von der Ohe et al. discloses:*

- The two lining portions covering the longitudinal sides of the axle carrier are joined together in such a way that they form a single component, the connecting portions fully covering the transverse bridges of the axle carrier, which join its longitudinal sides
    - Examiner takes official notice that it is old and well known in the art to paint and/or undercoat an axle carrier, as such painting or undercoating provides a single unified coating over all of the surfaces chosen to be covered by said lining. Therefore it would have been obvious to paint and/or undercoat the axle carrier of von der Ohe et al.

*With regards to claim 15, von der Ohe et al. discloses:*

- The lining is formed by a coating of the axle carrier
    - Examiner takes official notice that it is old and well known in the art to paint and/or undercoat an axle carrier, as such painting or undercoating is done by coating the axle carrier with said paint or undercoating. Therefore it would have been obvious to paint and/or undercoat the axle carrier of von der Ohe et al.

*With regards to claim 16, von der Ohe et al. discloses:*

- The lining is of skin-like configuration conforming to the contour of the top side of the axle carrier
    - Examiner takes official notice that it is old and well known in the art to paint and/or undercoat an axle carrier, as such painting or undercoating conforms to the surface to which it is applied. Therefore it would have been obvious to paint and/or undercoat the axle carrier of von der Ohe et al.

*With regards to claim 19, von der Ohe et al. discloses:*

- The material of the lining comprises polyamide or polyurethane
    - Examiner takes official notice that it is old and well known in the art to paint and/or undercoat an axle carrier, as such painting or undercoating are commonly composed of a polyamide or polyurethane. Therefore it would have been obvious to paint and/or undercoat the axle carrier of von der Ohe et al.

*With regards to claim 20, von der Ohe et al. discloses:*

- An axle carrier upon which the engine is mounted (Figure 1, Item 1)
- At least one pre-manufactured liner attached to at least one area of the axle carrier
    - Examiner takes official notice that it is old and well known in the art to paint and/or undercoat an axle carrier, as such painting or undercoating is pre-manufactured and then applied to whatever component is desired to

be lined with said paint or undercoating. Therefore it would have been obvious to paint and/or undercoat the axle carrier of von der Ohe et al.

- The liner is a material with heat-insulating and sound-insulating properties
    - Examiner takes official notice that it is old and well known in the art to paint and/or undercoat an axle carrier, as such painting or undercoating provides heat-insulating and sound-insulating properties as opposed to a bare metal surface. Therefore it would have been obvious to paint and/or undercoat the axle carrier of von der Ohe et al.

*With regards to claim 21, von der Ohe et al. discloses:*

- The liner is attached to the axle carrier via screws, glue, or clips
    - Examiner takes official notice that it is old and well known in the art to paint and/or undercoat an axle carrier, as such painting or undercoating inherently by its chemical make-up has a bonding agent inside of it that is glue. Therefore it would have been obvious to paint and/or undercoat the axle carrier of von der Ohe et al.

*With regards to claim 21, von der Ohe et al. discloses:*

- The lining is pre-manufactured and attached to the axle carrier via screws, glue, or clips
    - Examiner takes official notice that it is old and well known in the art to paint and/or undercoat an axle carrier, as such painting or undercoating inherently by its chemical make-up has a bonding agent inside of it that is

glue. Therefore it would have been obvious to paint and/or undercoat the axle carrier of von der Ohe et al.

***Allowable Subject Matter***

**3. Claims 5-10, 14, and 17-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.**

*With regards to claims 5-6:*

- The allowable subject matter present in the claim is that the material of the lining consists of two interconnected plastics, the one plastic exhibiting sound-insulating properties and the other plastic exhibiting heat-insulating properties. Therefore claim 5 and any claims that depend therefrom are considered to contain allowable subject matter.

*With regards to claim 7:*

- The allowable subject matter present in the claim is that the lining covers a track control arm opening. Therefore claim 7 and any claims that depend therefrom are considered to contain allowable subject matter.

*With regards to claim 8:*

- The allowable subject matter present in the claim is that the lining covers a track control arm opening. Therefore claim 8 and any claims that depend therefrom are considered to contain allowable subject matter.

*With regards to claim 9:*

- The allowable subject matter present in the claim is that the lining covers an interspace between the axle carrier and a longitudinal member of the vehicle to which the axle carrier is fastened. Therefore claim 9 and any claims that depend therefrom are considered to contain allowable subject matter.

*With regards to claim 10:*

- The allowable subject matter present in the claim is that the lining covers a bearing of the axle carrier for an axle stabilizer. Therefore claim 10 and any claims that depend therefrom are considered to contain allowable subject matter.

*With regards to claim 14:*

- The allowable subject matter present in the claim is that the lining, with the exception of fastening points for fastening the lining to the axle carrier, is distanced from the latter by an air gap. Therefore claim 14 and any claims that depend therefrom are considered to contain allowable subject matter.

*With regards to claim 17:*

- The allowable subject matter present in the claim is that there are air chambers formed on a top side of the lining. Therefore claim 17 and any claims that depend therefrom are considered to contain allowable subject matter.

*With regards to claim 18:*

- The allowable subject matter present in the claim is at points of covered openings in the axle carrier , on a circular surface, the lining is provided with diametrical slots, with slotted leaves which are hereupon formed being of

resiliently elastic configuration. Therefore claim 18 and any claims that depend therefrom are considered to contain allowable subject matter.

***Response to Arguments***

4. **Applicant's arguments filed on the 24th of July 2008 have been fully considered but they are not persuasive.** The specific arguments of applicant that are not persuasive are those dictated towards the definition of the term lining as well as any arguments concerning the use of undercoating as a lining. Undercoating as has been cited before via Miller (US 3,434,851) in previous actions, is considered a lining via examiner as has been explicitly indicated by the providing of a conventional definition. Additionally, applicant's own specification states that the lining may be a coating in Paragraph [00011]. With respect to applicant's specific argument that "a separate tough shell is placed in a truck bed is understood to be a liner", examiner invites applicant to search "RHINO® Bed Liner" in an internet text search or "Spray-On Bed Liners" and applicant will find a wide range of spray in bed-liners (similar to undercoating and painting), and it is noted that these products are sprayed on like a paint or undercoating and are explicitly termed as being "liners" or "linings".

5. **Applicant's arguments, see page 7, (b.), of applicant's arguments, filed the 24th of July 2008, with respect to the rejection using Illbruck et al. have been fully considered and are persuasive.** The rejection of claims 5-10, 14, and 17-18 has been withdrawn.

***Conclusion***

6. **Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN R. OLSZEWSKI whose telephone number is (571)272-2706.** The examiner can normally be reached on M-Th 5:30AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Ellis can be reached on 571-272-6914. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. R. O./
Examiner, Art Unit 3618

/Christopher P Ellis/
Supervisory Patent Examiner, Art Unit 3618